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10/584,764	05/10/2007	Liangshen Chen	4502-1068	5796
<div>466 7590 03/10/2010</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
EXAMINER				
RAHMAN, MAHPUZUR				
ART UNIT		PAPER NUMBER		
2438				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/584,764

Applicant(s)

CHEN ET AL.

Examiner

MAHFUZUR RAHMAN

Art Unit

2438

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-12 are examined and are pending. Claims 1-11 are amended. Claim 12 is new.

Response to Arguments

1. Applicants amendment to claims 1 and 8 filed on November 4, 2009 necessitated a new ground of rejection presented in this Office Action. The previously presented rejections have changed because the limitations "digital media having a license number and installed with a user agent" and "digital media containing a license code" have newly been added to claim 1 and claim 8 respectively. Further, limitations "the target being the computer running the same program with the same license number and with content being" and "the concatenated code" are added to claims 4 and 5 respectively. Thus applicant's arguments filed on November 4, 2009 have been rendered moot in view of the new ground(s) of rejection. The reference of Oshima has been introduced to the references of Pradhan to address the newly added limitations. The reasons of obviousness are included below in this office action.

Claims 1 and 8 are now rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan et al. (US 2004//0235521 A1, hereinafter, Pradhan) in view of Oshima et al. (US 2003/0177098 A1; hereinafter, Oshima).

Claim Objections

2. Claims 1, 5, and 7 are objected to because of the following informalities: drawing labels are being added to claim limitations such as "network data packets (202)", "media initialization (205)", "the network (206)", "unique license code (101, 102)", "license code (104)", "the digital media (106, 108)". "disc (106)" in above mentioned claims. Claim elements should not have drawing labels such as "101", "102" as a part of claim limitation. Appropriate correction is requested.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan et al. (US 2004//0235521 A1, hereinafter, Pradhan) in view of Oshima et al. (US 2003/0177098 A1; hereinafter, Oshima).**

Regarding claim 1, Pradhan discloses a method of managing the rights to digital media having a license number and installed with a user agent in a network environment (Paragraph 0049: access rights associated with digital media in a network environment) comprising:

at initialization of digital media having a [license number and installed with a user agent], the user agent detecting network data packets (202) containing license number information of other such digital media including programs running on the network

(Paragraph 0034: identifying/authenticating media cards when different types of media (i.e. digital media) associated with pseudo-license (i.e. license number) is detected on the network at initialization) and

when the detected license number is identical (203) to that being initialized preventing initialization continuing (Paragraph 0028: transmitting access rights between system users wherein the access rights allow access to certain types of transferable media and thereby eliminating the theft of intellectual property rights related to the media), or

when the detected license number is not identical to that being initialized allowing digital media initialization (205) packet ((Fig. 11: Step 1120: Allowing the device to transmit at least one access right to the media to the user identifier based on a second transaction between the user identifier and the device) and

then broadcasting the license number into the network (206) in a data (Paragraph 0028: transmitting access rights information (i.e. license number) with digital media (i.e. data) once access right information is validated) .

Pradhan does not explicitly disclose but Oshima from the same or similar fields of endeavor teaches installing a user agent (Paragraphs 0003 and 0005: installing the disks' IDs on the hard disks of personal computers, or mail to users IDs prepared centrally. when the disks have been distributed to users, the user ID numbers, the cipher keys for transmission for communication, and the decoding keys for reception are distributed automatically to the users) and having a license number (Paragraph 0014: content part that has been licensed; Fig. 9) wherein

digital media initialization is being prevented when the license number is identical (Fig. 12, Block 877h: Coincidence, Block 877j: Stop or Warn; Paragraph 0066: Illegal installation is detected by checking duplication of the soft IDs of the personal computers. If there is illegal installation, a warning message is sent to the appropriate personal computer/s) and

being allowed when the license number is not identical (Fig. 12, Block 877k: No coincidence, Allow start; Paragraph 0066: If there are no illegal copies. Then the procedure goes to Step 877k, where the start of the program is permitted; Paragraph 0060: the content and ID are recorded on the hard disk. This ID checks to determine if there is no same ID on a network when the program has started, and the ID actuates the network protection).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention installing a user agent and having a license number as taught by Oshima in the teachings of Pradhan for the advantage of providing IDs and cipher keys for ROM disks in electronic distribution systems (Paragraph 0005) and thus protecting digital contents from making illegal copies (Paragraph 0067).

Regarding claim 2, the combination of Pradhan and Oshima discloses a method as claimed in claim 1 wherein the digital media once initialized replicates onwards packets from other instances of the digital media accessed or running elsewhere on the network (Pradhan, Paragraphs 0037 and 0039: accessing digital

media associated with access rights using decryption key; Fig. 4: media files transmission on the network)

Regarding claim 3, the combination of Pradhan and Oshima discloses a method as claimed in claim 1 wherein the digital media is a program running on the network (Pradhan, Paragraphs 0037 and 0039: transmission of digital media such as music, movies on the network) .

Regarding claim 4, the combination of Pradhan and Oshima discloses a method as claimed in claim 3 comprising:

when a packet containing a license number identical to that of a program being initialized detected (Pradhan, Paragraph 0034: access rights such as a license associated with digital media)

broadcasting to the network a packet with the target being the computer running the [same program with the same license number] and with content being a "halt" command, receiving the halt command in the computer and causing the computer to shut down the running instance of the same program (Oshima, Fig. 12, Block 877h: Coincidence, Block 877j: Stop or Warn; Paragraph 0066: Illegal installation is detected by checking duplication of the soft IDs of the personal computers. If there is illegal installation, a warning message is sent to the appropriate personal computer/s).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to stop the running instance of same program with same license

number as taught by Oshima in the teachings of Pradhan for the advantage preventing multiple installation of the software of the same ID on the same network. Thus, simple protection from illegal copies is realized (Paragraph 0067).

Regarding claim 6, the combination of Pradhan and Oshima discloses a method as claimed in claim 5 further comprising the step of generating a user code from the encrypted code (Oshima, Paragraph 0088: generating a second cipher, which is the contents enciphered with the disk ID of a particular disk; Paragraph 0079: second cipher key is generated wherein user data enciphered with the second cipher key is sent through the internet for communication between two computers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to generate a user code as taught by Oshima in the teachings of Pradhan from the advantage of transmitting user ID numbers, cipher keys for communication and distributing decoding keys for reception to the users. It is therefore possible to omit some of the procedures that complicate conventional systems. Also, crypto communication and the identification of disks are made possible at the same time (Paragraph 0005).

Regarding claim 7, the combination of Pradhan and Oshima discloses a method as claimed in claim 1 wherein the user agent is embedded in a multimedia file or disc (106) (Pradhan, Paragraph 0049: encrypted multimedia files stored in MP3 player) .

Regarding claim 8, Pradhan discloses a computer when running [a user agent of digital media containing a license code], which user agent on initialization recognizes other instances of the digital media on the network (Paragraph 0012: a computer program identifying access right information associated with digital media (i.e. other instances of the digital media) on the network at initialization)

a detector which detects a positive comparison and prevents initialization of the digital media when an identical license code is found (Paragraph 0049: identifying access right information (i.e. license number) and a positive match resulting in prevention of initial authorization process).

a comparator which compares the license code of other instances of the digital media on the network with the license code of the initializing version (Fig.2 Step 230: Based on a second transaction between the user identifier and the device allowing the device to transmit at least one access right to a media) ,

an initialization invocation which initializes the digital media and broadcasts the digital media license code if the license code is not found (Fig. 11: Step 1120: Allowing the device to transmit at least one access right to the media to the user identifier based on a second transaction between the user identifier and the device) and

a detector which detects a positive comparison and prevents initialization of the digital media when an identical license code is found (Paragraph 0028: transmitting access rights between system users wherein the access rights allow access to certain

types of transferable media and thereby eliminating the theft of intellectual property rights related to the media).

Pradhan does not disclose but Oshima from the same or similar fields of endeavor teaches a user agent of digital media containing a license code (Paragraphs 0003 and 0005: installing the disks' IDs on the hard disks of personal computers, or mail to users IDs prepared centrally. when the disks have been distributed to users, the user ID numbers, the cipher keys for transmission for communication, and the decoding keys for reception are distributed automatically to the users; Paragraph 0014: content part that has been licensed) wherein

digital media initialization is being prevented when the license number is identical (Fig. 12, Block 877h: Coincidence, Block 877j: Stop or Warn; Paragraph 0066: Illegal installation is detected by checking duplication of the soft IDs of the personal computers. If there is illegal installation, a warning message is sent to the appropriate personal computer/s) and

being allowed when the license number is not identical (Fig. 12, Block 877k: No coincidence, Allow start; Paragraph 0066: If there are no illegal copies. Then the procedure goes to Step 877k, where the start of the program is permitted; Paragraph 0060: the content and ID are recorded on the hard disk. This ID checks to determine if there is no same ID on a network when the program has started, and the ID actuates the network protection).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention installing a user agent and having a license number as taught by

Oshima in the teachings of Pradhan for the advantage of providing IDs and cipher keys for ROM disks in electronic distribution systems (Paragraph 0005) and thus protecting digital contents from making illegal copies (Paragraph 0067).

Regarding claim 9, the combination of Pradhan and Oshima teaches a computer as claimed in claim 8 wherein the comparator may also detect a "halt" instruction from an initialization invocation on a computer which is using an identical license code (Oshima, Fig. 12, Block 877h: Coincidence, Block 877j: Stop or Warn; Paragraph 0066: Illegal installation is detected by checking duplication of the soft IDs of the personal computers. If there is illegal installation, a warning message is sent to the appropriate personal computer/s).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to stop the running instance of same program with same license number as taught by Oshima in the teachings of Pradhan for the advantage preventing multiple installation of the software of the same ID on the same network. Thus, simple protection from illegal copies is realized (Paragraph 0067).

Regarding claim 10, the combination of Pradhan and Oshima teaches a computer as claimed in claim 8 wherein on detection by the detector of a positive comparison, a network interface broadcasts a "halt" indication to the originating user agent (Oshima, Fig. 12, Block 877h: Coincidence, Block 877j: Stop or Warn; Paragraph 0066: Illegal installation is detected by checking duplication of the soft IDs of the

personal computers. If there is illegal installation, a warning message is sent to the appropriate personal computer(s).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to stop the running instance of same program with same license number as taught by Oshima in the teachings of Pradhan for the advantage preventing multiple installation of the software of the same ID on the same network. Thus, simple protection from illegal copies is realized (Paragraph 0067).

Regarding claim 11, the combination of Pradhan and Oshima teaches a computer as claimed in claim 8 wherein the user agent is invoked from a multimedia disc or file (Pradhan, Paragraph 0047: MP3 player program for playing media files, for example).

Regarding claim 12, the combination of Pradhan and Oshima teaches the method of claim 1, wherein, the license number of the digital media comprises a license code and a verification code (Oshima, Paragraph 0068: the original disk's own identification data is recorded in the form of a bar code. At Step 853h, an ID and/or other identification information is printed in the format of a bar code for POS on each disk; Paragraph 0046: If a digital signature is made by the second cipher encoder with the secret key, the user's signature can be confirmed in the second cipher decoder wherein the cipher key (public key) for crypto communication or the secret key for digital

signature has been recorded in the BCA. It is therefore possible to prevent third parties' unauthorized accounting and orders).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to stop the running instance of same program with same license number as taught by Oshima in the teachings of Pradhan for the advantage preventing multiple installation of the software of the same ID on the same network. Thus, simple protection from illegal copies is realized (Paragraph 0067).

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan in view of Oshima as applied to claim 1 above, and further in view of Pearson et al. (Patent No. US 7,461,249 B1).

Regarding claim 5, the combination of Pradhan, Oshima and Pearson discloses a method of generating a license number for digital media as claimed in claim 1 consisting of:

generating a unique license code (101, 102) (Pearson, Col. 2 lines 59-63: producing a first hash by hashing the license-related code) ;

generating from the license code a verification code and concatenating this to the license code (104) and encrypting the concatenated code (105) and dispersing the [concatenated code] with the digital media (106,108) (Pearson, Col. 23 lines 21-28: the user smart card generates and returns a response comprising the concatenation of: the plain text of the nonce A, a new nonce B generated by the user smart card , the ID of

the trusted device and some redundancy; the signature of the plain text, generated by signing the plain text with the private key of the user smart card ; and a certificate containing the ID and the public key of the user smart card 19)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use concatenated code with the digital media in order to protect or meter many types of information, audio and video clips, streaming media, software, graphics, multimedia materials and thereby achieving a more secure booting, together with integrity checks on other code to ensure that unauthorised modifications have not been made to the operating systems and mounted software (Col. 1 lines 19-29).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAHFUZUR RAHMAN whose telephone number is (571)270-7638. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi T. Arani can be reached on (571) - 272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R./
Examiner, Art Unit 2438

/Taghi T. Arani/
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